

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

PURDUE PHARMA PRODUCTS L.P., NAPP  
PHARMACEUTICAL GROUP LTD., BIOVAIL  
LABORATORIES INTERNATIONAL SRL, and  
ORTHO-MCNEIL, INC.,

Plaintiffs,

v.

PAR PHARMACEUTICAL, INC. and PAR  
PHARMACEUTICAL COMPANIES, INC.,

Defendants.

C.A. No. 07-255-JJF

**REDACTED  
PUBLIC VERSION**

**DEFENDANTS' SUPPLEMENTAL BRIEF IN SUPPORT OF  
MOTION TO COMPEL PRODUCTION OF CERTAIN  
DISCOVERY AND AMEND SCHEDULING ORDER**

Of Counsel:

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Dated: August 22, 2008

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*Attorneys for Defendants Par Pharmaceutical,  
Inc. and Par Pharmaceutical Companies, Inc.*

### **INTRODUCTION**

Par's Motion to Compel Production of Certain Discovery and Amend Scheduling Order (D.I. 152) was scheduled for oral argument on July 11. On July 9, the Court took the Motion under advisement, and informed the parties that the Motion would be decided on the papers. Par submits this supplemental brief to apprise the Court of two facts that arose subsequent to the completion of briefing, and that Par would have informed the Court of during oral argument. First, contrary to their opposition brief, plaintiffs Purdue Pharma Products L.P. and Napp Pharmaceutical Group Ltd.'s ("plaintiffs") recent admissions confirm that the subject matter waiver issue concerning the Merck reference is not moot. Second, after Par submitted its reply brief on July 3, plaintiffs recalled more than 50 additional documents.

### **ARGUMENT**

**A. Information Obtained Since Par Filed Its July 3 Reply Brief Confirms That, Contrary To Plaintiffs' Assertion, Subject Matter Waiver Issue Is Not Moot**

Plaintiffs stated in their opposition brief that "Par's motion to compel production of Merck testing documents is moot" and "the documents that Par seeks by this motion were produced before the motion was filed, except for sixteen additional documents that are being produced today." (D.I. 176, at 13). Plaintiffs' contentions are wrong and misleading. Plaintiffs continue to withhold internal documents on the basis that there has been no subject matter waiver relating to the Merck reference. Moreover, plaintiffs continue to prevent deposition testimony on the basis that there has been no subject matter waiver relating to the Merck reference.

If the subject matter waiver issue is moot as plaintiffs asserted, then documents relating to testing using the Merck reference should not be withheld on the grounds of privilege. Unfortunately, plaintiffs are still withholding documents and maintaining that there has not been a subject matter waiver.

After recent depositions, Par requested internal Napp analytical data from experimentation that followed the teachings of the Merck reference.

**REDACTED**

Specifically, Napp did not produce the analytical data corresponding to Napp's LIMS reference numbers **REDACTED**

Par requested this analytical information during the depositions and subsequently in writing.

In response to requests for this information, Par was initially informed that Napp had "not located" the analytical data. (Ex. A, 6/30/08 Wang letter). Subsequently, on July 8 Par was informed by Napp, for the first time, that the requested analytical data in fact existed and had been located at Napp. Par was further informed that Napp was withholding this analytical data as privileged. There is no privilege associated with the requested data, however, because as set forth in Par's opening and reply briefs in support of its Motion to Compel (D.I. 153 and 184), there has been a subject matter waiver. Napp cannot submit favorable results to the Patent Office regarding patentability over the Merck reference and simultaneously withhold other experimentation based on the same reference.

**REDACTED**

(Ex. B, Leslie Tr. 17:20-18:1).

Plaintiffs should produce the analytical data

**REDACTED**

for experimentation using the Merck reference as a guideline as well as other requested documents in view of the subject matter waiver concerning the Merck reference. Moreover, plaintiffs should produce all documents from their privilege logs relating to experimentation using the Merck reference as a guideline.

**B. Plaintiffs Recalled Over 50 More “Inadvertently” Produced Documents After Par Filed Its July 3 Reply Brief**

As expected, on July 5, 2008 -- the eve of leaving for London to take the depositions of two named inventors of the patents-in-suit -- plaintiffs recalled an additional 53 documents. (Ex. C, 7/5/08 Huang letter). This was the seventeenth time plaintiffs have recalled documents by letter, i.e. not including the recalling of documents during depositions. Yet another indication that the recalling of documents to Par's prejudice has not ended.

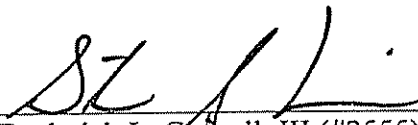
**CONCLUSION**

For the foregoing reasons and the reasons set forth in its opening and reply briefs, Par respectfully requests that the Court order the requested relief.

Of Counsel

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Dated: July 10, 2008

  
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Inc. and Par Pharmaceutical Companies, Inc.

**IN THE UNITED STATES DISTRICT COURT  
DISTRICT OF DELAWARE**

**CERTIFICATE OF SERVICE**

I hereby certify that on August 22, 2008, I electronically filed the foregoing document with the Clerk of Court using CM/ECF which will send notification of such filing(s) and Hand Delivered to the following:

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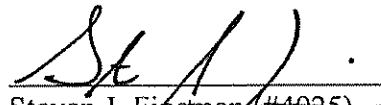
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I hereby certify that on August 22, 2008, I have sent by Electronic Mail, the foregoing document to the following non-registered participants:

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# **EXHIBIT A**



ROPES & GRAY LLP  
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June 30, 2008

Thomas A. Wang  
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thomas.wang@ropesgray.com

**BY E-MAIL (CONFIRMATION COPY BY FEDEX)**

Robert E. Colletti, Esq.  
Frommer Lawrence & Haug LLP  
745 Fifth Avenue  
New York, NY 10151

Re: *Purdue et al. v. Par Pharmaceutical et al.*

Dear Rob:

Further to Paddy Chinta's e-mail to you of June 27, 2008, enclosed is a CD containing a copy of Napp's stability notebook relating to its experiments from the Napp v. Asta litigation.

The CD also includes documents concerning Napp's experimental testing based on the Merck/Bondi reference in connection with foreign patent office proceedings or foreign patent litigation. These documents were previously withheld from the DDK production.

We are still looking for the clinical study report TH096-0402 but have not located any of the other documents requested in your June 23 letter to Ms. Chinta.

Regards,

A handwritten signature in cursive script that reads "Thomas A. Wang".

Thomas A. Wang

TAW:taw

Enclosure (via FedEx)

EXHIBIT B

REDACTED  
IN ITS  
ENTIRETY



# **EXHIBIT C**



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July 5, 2008

Henry Y. Huang  
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henry.huang@ropesgray.com

**BY E-MAIL (CONFIRMATION BY FEDEX)**

Robert E. Colletti, Esq.  
Frommer Lawrence & Haug LLP  
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New York, NY 10151

*Purdue et al. v. Par*

Dear Mr. Colletti:

We hereby request the return of the following inadvertently and/or unintentionally produced documents as protected by the attorney/client privilege and/or work product immunity pursuant to ¶ 10 of the Protective Order:

Bates Begin	Bates End
NAPP0037215	NAPP0037235
NAPP0037521	NAPP0037522
NAPP0075283	NAPP0075297
NAPP0097919	NAPP0097931
NAPP0097932	NAPP0097944
NAPP0142846	NAPP0142858
NAPP0341071	NAPP0341072
NAPP0384742	NAPP0384745
NAPP0391246	NAPP0391427

We hereby request the return of the following inadvertently produced documents as protected by the attorney/client privilege and/or work product immunity pursuant to ¶ 10 of the Protective Order, which are being re-produced on the enclosed CD with redactions and will have the same production numbers as before:

Bates Begin	Bates End
NAPP0036643	NAPP0036696
NAPP0037521	NAPP0037522

ROPES & GRAY LLP

Robert E. Colletti, Esq.

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July 5, 2008

Bates Begin	Bates End
NAPP0041104	NAPP0041192
NAPP0041303	NAPP0041305
NAPP0041805	NAPP0041808
NAPP0043347	NAPP0043352
NAPP0067704	NAPP0067711
NAPP0075283	NAPP0075297
NAPP0075331	NAPP0075334
NAPP0075961	NAPP0075965
NAPP0096039	NAPP0096051
NAPP0096244	NAPP0096247
NAPP0096279	NAPP0096280
NAPP0096281	NAPP0096282
NAPP0096427	NAPP0096428
NAPP0097064	NAPP0097066
NAPP0097018	NAPP0097019
NAPP0097367	NAPP0097368
NAPP0097499	NAPP0097500
NAPP0097919	NAPP0097931
NAPP0097932	NAPP0097944
NAPP0098156	NAPP0098157
NAPP0142846	NAPP0142858
NAPP0241909	NAPP0241912
NAPP0241913	NAPP0241917
NAPP0271071	NAPP0271074
NAPP0272790	NAPP0272794
NAPP0272795	NAPP0272800
NAPP0272885	NAPP0272886
NAPP0341071	NAPP0341072
NAPP0342889	NAPP0342891
NAPP0383331	NAPP0383342
NAPP0384742	NAPP0384745
NAPP0384746	NAPP0384750
NAPP0390857	NAPP0390858
NAPP0391171	NAPP0391179

ROPES & GRAY LLP

Robert E. Colletti, Esq.

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July 5, 2008

Bates Begin	Bates End
NAPP0391246	NAPP0391247
PUR0775590	PUR0775592
PUR0775601	PUR0775603
PUR0776073	PUR0776074
PUR0776076	PUR0776077
PUR0776078	PUR0776079
PUR0776851	PUR0776852
PUR1048556	PUR1048564

Please confirm in writing once Par has complied with the requirements of ¶ 10 of the Protective Order with respect to the above identified inadvertently produced documents.

Sincerely,



Henry Y. Huang

HYH:tc